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Amendment in Reply to Advisory Action of September 8, 2005

REMARKS

Reconsideration of the present application and entry of the present Supplemental Amendment are respectfully requested.

At the outset, it is respectfully pointed out that the Advisory Action does not indicate whether the Amendment sent via facsimile on August 22, 2005 (in response to the Final Office Action of July 15, 2005) was entered. Based on the content of the Advisory Action, it is assumed that the Amendment of August 22, 2005 was entered, and thus the changes to the claims in the present Supplemental Amendment are based on this assumption. If this assumption is incorrect, Applicant respectfully requests notification.

By means of the present Supplemental Amendment, independent claim 17 has been amended for better clarity. Claim 17 was not amended in order to address issues of patentability and Applicant respectfully reserves all rights he may have under the Doctrine of Equivalents. Further, Applicant reserves his right to reintroduce the original or previously amended claims, or subject matter deleted herein at a later time during the prosecution of this

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Application or Continuing Applications.

Further, independent claims 1, 8 and 15-16 have been amended to include a feature similar to that in independent claim 17, where dependent claims 4-5, 11-12 and 21-22 have also been amended for conformance to the amended independent claims 1, 8 and 15-17.

Claims 1, 4-5, 8, 11-12, 15-17 and 21-22, as amended, better claim the present invention in line with the arguments presented in the Amendment of August 22, 2005, as well as the arguments presented by the Examiner in the Advisory Action. Accordingly, the amendments to claims 1, 4-5, 8, 11-12, 15-17 and 21-22 do not introduce new matter requiring a new search and do place the claims in better form for appeal, and thus entry of the present Supplemental Amendment is respectfully requested.

In the Final Office Action, claims 1-2, 4-9, 11-18 and 21-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over International Publication No. WO 01/15449 A1 (Vamparys) in view of U.S. Patent No. 5,758,257 (Herz) and U.S. Patent No. 6,445,398 (Gerba). Further, the Advisory Action indicated that the Amendment of August 22, 2005 does not place the present Application in condition for allowance. Applicant respectfully submits that

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claims 1-2, 4-9, 11-18 and 21-24, as amended, are patentable over Vamparys, Herz and Gerba for at least the following reasons, where the arguments presented in the Amendment of August 22, 2005 are incorporated herein by reference.

In the Advisory Action the Examiner correctly notes that:

neither the Vamparys nor Herz references teach that an image of the celebrity is displayed during the step of reporting the recommendation to the user through the celebrity agent, as claimed. In fact, the Herz reference only goes as far as to disclose that, "each customer can adopt the customer profiles of other individuals or programs such as 'celebrity' profiles including the viewing references of different celebrities" [col. 49, lines 1-4] The Gerba reference, however does go as far as to teach that, "an animated or taped or live video host 300 introduces the viewer to upcoming or currently available programs 302 and provides suggestion designed to assist the viewer in reviewing programming choices" [col. 18, lines 55-58] (Emphasis Added in both citations).

In the Advisory Action, the Examiner maintains that:

it would have been to one of ordinary skill in the art to include the taped, animated, or live video host for introducing suggested programming, in order to assist the viewer in reviewing programming choices and recommendations of the celebrity. The celebrity of the Herz reference provides programming recommendation and the host of the Gerba reference provides programming recommendations, so why wouldn't it have been obvious for the host to be the celebrity? After

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all, if the celebrity profile were being used to make the recommendations, wouldn't it have been clearly obvious to display the video of the celebrity making those recommendations?

(Underling added)

It is respectfully submitted that if it was so obvious without using impermissible hindsight, then why is there no such suggestion in Vamparys, Herz, Gerba, and combinations thereof? Might it be that it did not occur to Vamparys, Herz, and Gerba that a celebrity may be interested in or used for announcing recommendations based on his or her profile?

The prior art must be examined in light of the teachings of the prior art. The prior art may not be examined utilizing the teachings of the present application. There can be no suggestion or motivation to modify a reference if the proposed modification changes the principle of operation the reference.

Applicant respectfully submits that present invention as recited in independent claims 1, 8 and 15-17 can only be arrived using impermissible hindsight. There is nothing whatsoever in Vamparys, Herz, Gerba, or combinations thereof, to suggest making a recommendation for based on the celebrity profile, and reporting the recommendation to the user through the very same celebrity,

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such as simultaneously displaying an image of this very same celebrity, as recited in independent claims 1, 8 and 15-17.

When Vamparys, Herz and Gerba are reviewed without utilizing the teachings of the present application, then it is clear that Vamparys, Herz, Gerba, and combinations thereof, do not disclose or suggest using a celebrity agent as recited in independent claims 1, 8 and 15-17. Without utilizing the teachings of the present application as a road map and hindsight reasoning, a person skilled in the art could not, in an obvious manner, arrive at the present invention as recited in independent claims 1, 8 and 15-17.

In consideration of the use of improper hindsight for rendering a claim obvious in light of the prior art, the Federal Circuit has stated that "to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction - an illogical and inappropriate process by which to determine patentability." (Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996)). "To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or

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suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." (In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited references omitted).'" (In re Kotzab, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). (Emphasis added)

Assuming, arguendo, that such a combination of Vamparys, Herz and Gerba does show the above-noted features independent claims 1, 8 and 15-17, namely, making a recommendation based on the celebrity profile, and reporting the recommendation to the user through the very same celebrity, such as simultaneously displaying an image of

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this very same celebrity, it is respectfully submitted that such a combination of Vamparys, Herz and Gerba is not proper. On page 3, lines 1-2 of the Advisory Action, the reason given for such a combination is "in order to assist the viewer in reviewing programming choices and recommendations of the celebrity." The last full paragraph on page 3 of the Advisory Action further states:

Also, the Examiner contends that the combination of references did not use impermissible hindsight. Most hosts in the television industry and in the art of television are also celebrities. Take, by way of example only, a talk show host, who is well known figure on the show, this talk show host is therefore a celebrity because of his "well known" status. Also, as proposed in a question before, the Examiner contends that it would have been clearly obvious to use a video of the celebrity because, since the celebrity profile is making the recommendation, it would only seem appropriate to have the celebrity as the host who is announcing the program recommendation via a video or image. (Emphasis added)

It is respectfully submitted that the above-cited motivation to make combinations of references finds no support in any of the cited references. Where is this desirability suggested from Vamparys, Herz and Gerba? Where is the suggestion in the references themselves or a proper motivation why one skilled in the

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art would be so motivated to combine these references? It is respectfully submitted that conclusory statements are utilized to justify the combination of Vamparys, Herz and Gerba.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1442, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art of knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

When determining obviousness, "[t]he factual inquiry whether to combine references must be thorough and searching." *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ 1430, 1433 (Fed. Cir. 2002), citing *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). "It must be based on objective evidence of record." Id. "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *In re Dembicza*k, 175 F.3d 994, 999, 50 USPQ2d 1614,

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1617. "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."

Dembiczak, 175 F.3d at 1000, 50 USPQ2d at 1617, citing McElmurry v. Ark. Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

The suggestion in the Final Office Action and Advisory Action that the combinations of prior art references would be obvious to one having ordinary skill in the art is respectfully refuted. One may not utilize the teachings of the present application as a road map to pick and choose amongst prior art references for the purposes of attempting to arrive at the presently disclosed invention. The Federal Circuit has identified three possible sources for motivation to combine references including the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. (See, In re Rouffet, U. S. Court of Appeals Federal Circuit, U.S.P.Q. 2d, 1453, 1458.) There must be a specific principle that would motivate a skilled artisan, with no knowledge of the present invention, to combine the prior art as suggested in the Office Action. The use of hindsight in the selection of references is forbidden in

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comprising the case of obviousness. Lacking a motivation to combine references, a proper case of obviousness is not shown (see, *In re Rouffet*, 1458).

The U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") restated the legal test applicable to rejections under 35 U.S.C. § 103(a) in the *In re Rouffet*, holding. The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *In re Rouffet*, 47 USPQ2d 1457-58

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(Fed. Cir., July 15, 1998) (citations omitted,
emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a). In this case the court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis. In re Dembicza, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both In re Rouffet and In re Dembicza it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them.

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The Examiner's reasoning for the motivation, namely, that those skilled in the art would have been motivated to combine Vamparys, Herz and Gerba, could only have been made with hindsight based on the teachings of the present disclosure. The Examiner's reasoning for the motivation for combining the references is nowhere recognized in the prior art nor does the Examiner attempt to make any showing that the art recognized such problems.

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Thus, Applicant again respectfully submits that the Examiner has used impermissible hindsight to reject claims 1, 4-5, 8, 11-12, 15-17 and 21-22 under 35 U.S.C. § 103(a). As discussed above, the Federal Circuit, in *In re Rouffet*, stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior

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art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicant respectfully submits that the Examiner has not met this burden.

The mere fact that the prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984); and In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989).

The only suggestion that can be found anywhere for making these combinations appears to come from the present patent application itself.

How can the Final Office Action and the Advisory Action espouse that this reconstruction of the present invention does not include knowledge gleamed only from the applicant's disclosure? If this reconstruction did not come from the present application, then where did it come from? The above reconstruction certainly did not come from the prior art. Even the Final Office Action and the Advisory Action do Final Office Action and the Advisory Action not

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point to any portions of the prior art for teaching the suggestion reconstructions/modification as pointed out above.

Applicant respectfully maintains that there is no suggestion in the prior art references to make the combinations in the manner proposed by the Examiner to achieve the Applicant's claimed invention.

The Examiner is requested to consider MPEP 2143, wherein it is stated:

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." And, "FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS ... The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)... Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.}.

It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of

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specificity with regard to the motivation to combine the cited references, that none of the suggested combinations of prior art utilized to reject each of claims 1, 4-5, 8, 11-12, 15-17 and 21-22 finds proper motivation for combination.

In summary, it is respectfully submitted that the combination of Vamparys, Herz and Gerba is not proper. Even assuming arguendo that such a combination is proper, it is still respectfully submitted that Vamparys, Herz, Gerba, and any combinations thereof, do not teach or suggest making a recommendation for based on the celebrity profile, and reporting the recommendation to the user through the very same celebrity, such as simultaneously displaying an image of this very same celebrity, as recited in independent claims 1, 8 and 15-17.

Accordingly, it is respectfully submitted that independent claims 1, 8 and 15-17 should be allowable, and allowance thereof is respectfully requested. In addition, it is respectfully submitted that claims 2, 4-7, 9, 11-14, 18 and 21-24 should also be allowed at least based on dependence from independent claims 1, 8 and 17, as well as for the separately patentable elements contained in each of the dependent claims.

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In addition, Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Applicant reserves the right to submit further arguments in support of the above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

In view of the above, it is respectfully submitted that the present application is in condition for allowance, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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